

### **REMARKS/ARGUMENTS**

The foregoing amendments in the specification and claims are of formal nature, and do not add new matter.

Prior to the present amendment, Claims 58-63 were pending in this application. With this amendment, Claim 58 has been amended to clarify what Applicants have always regarded as their invention, and Claim 63 has been canceled without prejudice. Claims 58-62 are pending after entry of the instant amendment.

Applicants expressly reserve the right to pursue any canceled matter in subsequent continuation, divisional or continuation-in-part applications.

#### **Priority**

Applicants rely on the inhibition of endothelial cell growth assay (Example 109, Assay 9) for patentable utility which was first disclosed in International Application No. PCT/US99/05028, filed March 8, 1999, priority to which has been claimed in this application. Accordingly, the present application is entitled to at least the March 8, 2000 priority for subject matter defined in Claims 58-65, 68-70 and 74-77.

#### **Utility**

Applicants note that utility is established based on Example 109, Ability of PRO Polypeptides to Inhibit Vascular Endothelial Growth Factor (VEGF) Stimulated Proliferation of Endothelial Cell Growth (Assay 9).

#### **Specification**

As requested by the Examiner, the title of the application has been amended to recite a new, descriptive title indicative of the invention to which the claims are directed.

In addition, the specification has been amended to remove embedded hyperlink and/or other form of browser-executable code.

### **Claim Objections**

Claim 63 is objected under 37 C.F.R. 1.75(c) as being improper dependent form for failing to further limit the subject matter of a previous claim.

Without acquiescing to the Examiner's position in the current rejections, and without prejudice to further prosecution of the subject-matter in one or more continuation or divisional applications, Applicants have canceled Claim 63. Accordingly, Applicants respectfully request reconsideration and withdrawal of the present objection.

### **Claim Rejections Under 35 U.S.C. §112, Second Paragraph**

Claim 63 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner alleges that the term "specifically binds" in Claim 63 is indefinite."

Applicants respectfully disagree and traverse the rejection.

Without acquiescing to the propriety of this rejection and solely in the interest of expedited prosecution in this case, Applicants have canceled Claim 63 and have amended Claim 58 (and, as a consequence, those claims dependent from the same) to recite "specifically binds." Applicants respectfully submit that the art-recognized meaning of "specific" binding is that the antibody that specifically binds to a particular antigen does not significantly cross-react with another antigen. Therefore, the term "specifically binds" in Claim 58 (and, as a consequence, those claims dependent from the same) clearly refers to an antibody that is able to bind to the PRO792 polypeptide without significantly cross reacting with another antigen. Accordingly, one skilled in the art would exactly know what the scope of the invention is, and the present rejection should be withdrawn.

### **Claim Rejections – 35 U.S.C. §102**

Claims 58-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Ford *et al.*, U.S. Patent No. 6,392,018, filed February 12, 1999 and issued May 21, 2002.

Applicants thank the Examiner for confirming the priority date of the cited reference as February 12, 1999 during telephone conference with Anna Barry on November 1, 2004.

Applicants respectfully submit the attached Declaration signed by all of the inventors, Dr. Ferrara, Dr. Goddard, Dr. Godowski, Dr. Gurney and Dr. Wood, the consideration of which is respectfully requested..

As stated in the Declaration and evidenced by Exhibit A, Applicants had obtained PRO320 polypeptide and had examined the effect of this polypeptide on the endothelial cell proliferation in the United States prior to February 12, 1999. The test results indicated that PRO320 inhibits the proliferation of endothelial cells induced by VEGF and has utility in cancer therapy and specifically in inhibiting tumor angiogenesis. Accordingly, the Declaration clearly shows that the invention claimed in the present application was conceived and reduced to practice prior to February 12, 1999. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the present rejection.

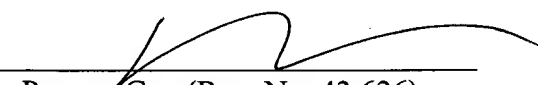
### CONCLUSION

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited. Should there be any further issues outstanding, the Examiner is invited to contact the undersigned attorney at the telephone number shown below.

Please charge any additional fees, including fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (referencing Attorney's Docket No. 39780-2630 P1C6)

Respectfully submitted,

Date: November 29, 2004

By:   
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